

## REMARKS

In the Office Action mailed from the United States Patent and Trademark Office on October 31, 2005, the Examiner rejected claims 1-10 and 16-20.

### Rejections under 35 U.S.C. § 103

In the Office Action, the Examiner rejected claims 1-4, 8, 9, 10, 16, 17 and 18 under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 5,423,240 to Fromm in view of U.S. Pat. No. 5,305,550 to Skonecki, U.S. Pat. No. 4,957,787 to Reinhardt, Japanese Pat. No. 59-016801 to Hirata and U.S. Pat. No. 5,142,976 to Roulleau. In addition, the Examiner rejected claims 5-7 and 19-20 under Section 103(a) as being unpatentable over Fromm in view of Skonecki, Reinhardt, Hirata and Roulleau in further view of U.S. Pat. No. 6,314,880 to Lampinski.

To establish a prima facie case of obviousness, three criteria must be met. First, there must be some suggestion or motivation . . . to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP 2142.

Applicants respectfully submit that the cited references do not teach every aspect of the claimed invention, as amended. In particular, independent claim 1 recites a method for providing a repeatable pad-printed image on a flower, the method comprising the steps for: producing a group of flowers, each flower having a stem and one or more petals, wherein said one or more petal(s) is free of an etched or cut image comprising: creating a repeatable, identical, pad-printed image provided on said petal that is free from an etched or cut image, said image selected from the group of: a communication from a sender of the group of flowers to an individual recipient of the group of flowers; a personalized communication to the individual

recipient of the group of flowers; a generic message to recipients in general; and a commemoration of an event. Independent claims 16 and 21 include similar limitations, and such limitations are supported by the disclosure as originally filed.

In contrast, the prior art does not explicitly or impliedly teach every aspect of the claimed invention. For example, Fromm does not teach the method and system for providing an image on a flower, as Applicants now claim in independent claims 1,16, and 21 respectively. Rather, Fromm discloses that his Children's Pad Printing Kit may print on the following surfaces: papers, plastics, ceramics, skin, leather and fabric, but makes no mention of flowers. See Fromm, column 5, lines 2-5. In contrast, Applicants disclose that the methods and processes of the present invention are "particularly useful in the floricultural industry." See page 4, lines 22-23 (emphasis added). In addition, Applicants disclose in many different places that their systems and processes provide images on flowers. See e.g., page 2, line 7; page 4, lines 3-7, 14-15, 18-21; page 7, lines 3-5, 7-8; page 9, lines 17-20; page 12, lines 18-20; page 13, lines 2-5.

Applicants respectfully submit that Skonecki does not teach the repeatable, pad printed limitations of amended claims 1 and 16. In addition, Fromm's Children's Pad Printing Kit is not meant for use on delicate surfaces such as flowers and as such, one skilled in the art would not think to combine it with Skonecki. For instance, according to Fromm's teachings, the Children's Pad Printing Kit is meant to be used on durable surfaces that allow re-use after washing the surface with a sponge. See Fromm, column 4, line 67 – column 5, line 5. In addition, Fromm specifically mentions that image removal is done without damage to the material of the surface and then goes on to include a list of such durable surfaces. See Fromm, column 4, line 67 – column 5, line 5. Notably absent from this list are flowers or any other delicate surfaces that could not withstand the rigor of washing for re-use. Thus, it is evident that there is no motivation

to combine Fromm's Children's Pad Printing Kit with Skonecki's Personalized Flower to generate the present invention's method and system for providing a repeatable, pad-printed image on a flower.

Further, Roulleau does not teach pad printing on an image as broad as a "delicate organic product." Roulleau specifically teaches printing on "uncooked poultry eggs." (Col. 3, 17-33). The claims and specification are clear on this point. (Id.) And, Roulleau teaches of printing in a way different than disclosed in Applicants' specification; on the egg by a machine comprising two angled facets. Applicants teach of printing on a petal that leaves a surface-only image on the petal. Second, "in spite of the fact that the claim may recite only process limitations, it is the patentability of the product claimed and not of the recited process steps which must be established." *In re Brown*, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972). The Federal Circuit held that only when the prior art discloses a product, which reasonably appears to be either identical with or only slightly different than a product claimed in a product -by-process claim is a section 103 rejection fair and acceptable. (Id.) The product described in Applicants' claimed invention as amended is neither identical nor only slightly different than the products disclosed in the prior art references. In particular, Roulleau discloses *eggs* with images on them, while. Applicants' claimed invention provides images on *petals* of flowers that are free from *etching or cuts*. Thus, the claimed invention is further rendered unobvious in light of the references.

For at least this reason, Applicant respectfully submits that the prior art does not explicitly or impliedly teach every aspect of the invention as claimed in the independent base claims. In addition, the dependent claims place further limitations on otherwise allowable subject matter. Accordingly, Applicant respectfully submits that the cited art does not teach

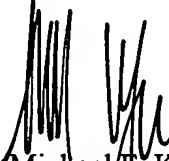
every aspect of the claims as provided herein and therefore does not render the claims obvious as provided herein.

### CONCLUSION

Applicants submit that the amendments made herein do not add new matter and that the claims are now in condition for allowance. Accordingly, Applicants request favorable reconsideration. If the Examiner has any questions or concerns regarding this communication, the Examiner is invited to call the undersigned.

DATED this 17 day of August, 2006.

Respectfully submitted,



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